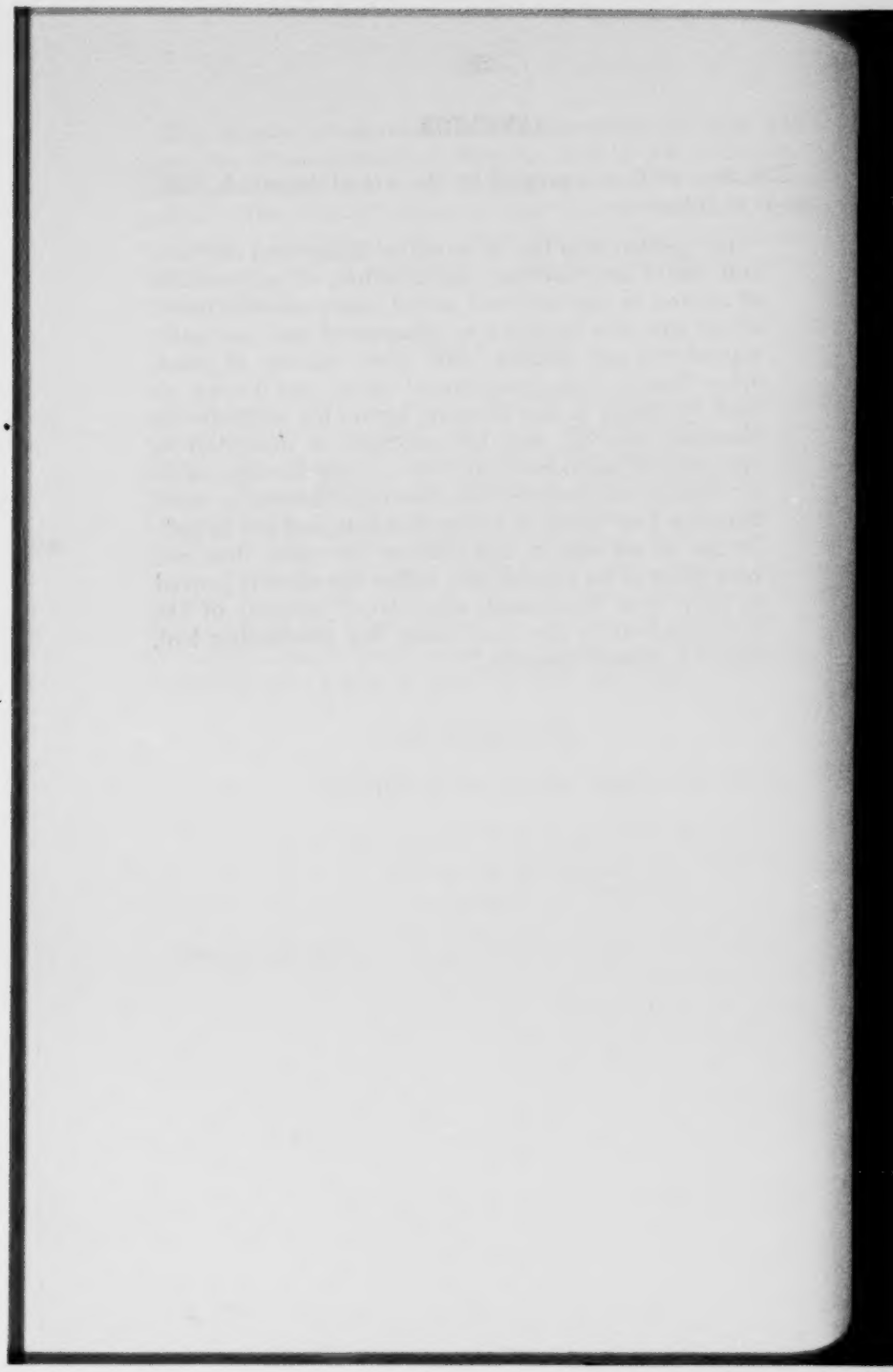

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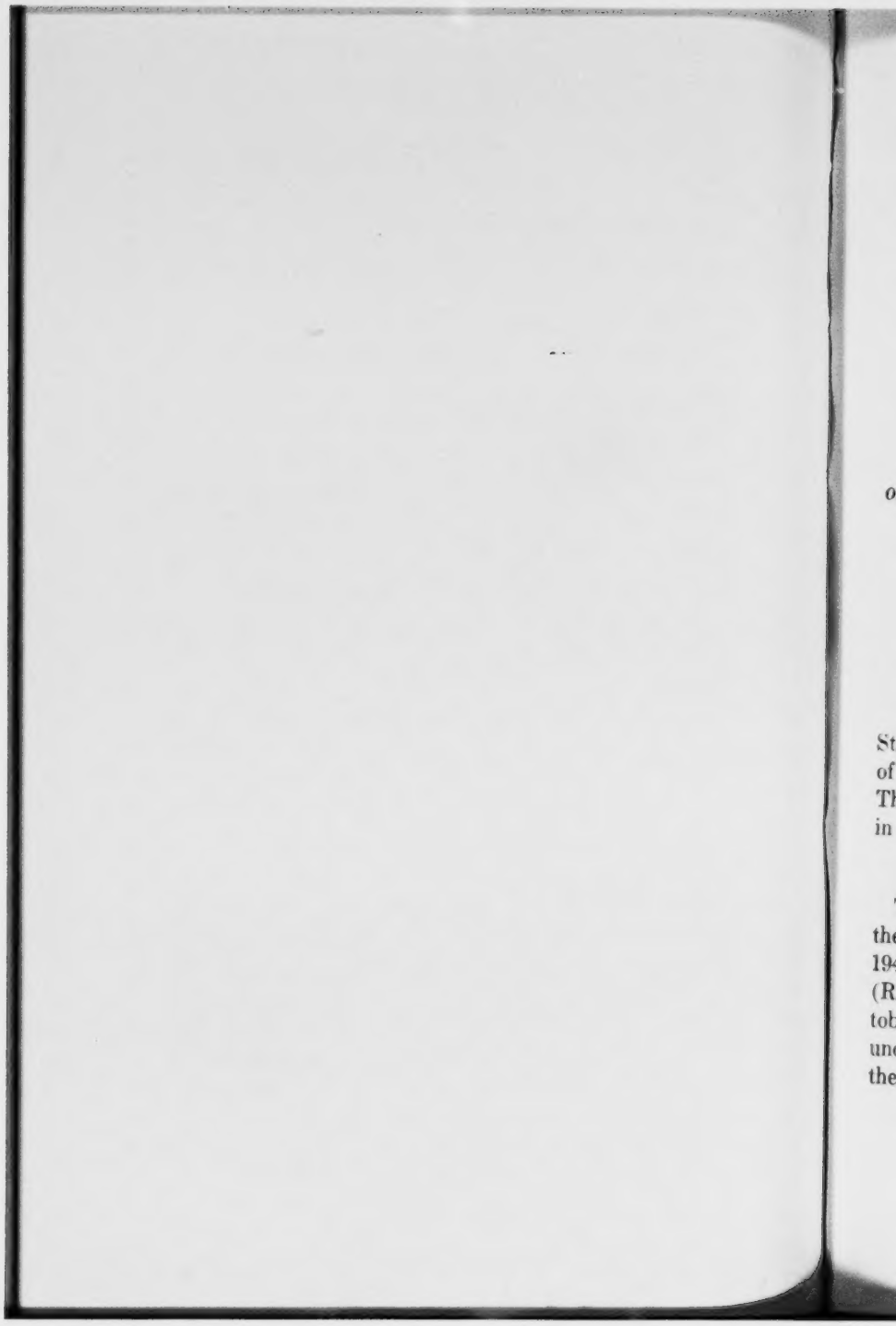

In the Supreme Court of the United States

OCTOBER TERM, 1941

No. 718

GENERAL MOTORS CORPORATION, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The memorandum of the District Court of the United States for the District of Columbia (R. 89) and the findings of fact and conclusions of law (R. 90–92) are not reported. The opinion of the Court of Appeals (R. 455–457) is reported in 120 F. (2d) 736.

JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia (R. 458) was entered on June 16, 1941. A motion for rehearing was denied on August 1, 1941 (R. 458). The petition for a writ of certiorari was filed October 27, 1941. The jurisdiction of this Court is invoked under section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTIONS PRESENTED

1. Whether, where invention is doubtful, a finding of no invention by the Patent Office and the District Court may be set aside on appellate review if there is substantial evidence to support such finding.

2. Whether, where invention is doubtful and the claimed invention has attained commercial success, the applicant is conclusively entitled to the issuance of a patent.

STATUTE INVOLVED

Revised Statutes, sec. 4915, as amended by the Act of March 2, 1927, sec. 11, 44 Stat. 1335, and Act of March 2, 1929, sec. 2 (b), 45 Stat. 1475 (35 U. S. C. 63):

> Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may

impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

STATEMENT

The petitioner is the assignee of a patent application filed in the Patent Office on July 25, 1930, by one Ernest E. Wilson (R. 3, 11). The application deals with a device for the absorption of the intake or exhaust noise of an internal combustion engine by means of resonators. The claims set forth in the application disclose a duct through which gases and sound waves travel and which communicates with a single or compound resonator, the resonator being tuned to respond to and attenuate the sound waves of a preselected frequency traveling through the duct (R. 3–8, 90–91, 379, 455). In commercial usage the petitioner's device has attained success and is now in general use in the automobile industry (R. 24–25, 41–43, 455). The prior art disclosed that sound could be absorbed by the use of resonators (R. 379–82, 389–98); that compound resonators were substantially more efficient than a single resonator (R. 382–84, 398–400); and provided formulae for computing the resonance frequency of both single and compound resonance chambers (R. 398–400, 412). The prior art also disclosed that the noises caused by an internal combustion engine are of a complex character, being made up of a mixture of sound waves of both high and low frequency (R. 307–11, 394), and that a resonator, in a complex sound field, responds simultaneously to the frequencies which are within the range of its response (R. 429–430).

Limited claims were allowed by the Patent Office. The Examiner, however, rejected certain broad claims (R. 402–441), which had theretofore been allowed by previous Examiners (R. 181, 192), and the rejection, with the exception of three claims, was sustained by the Board of Appeals of the Patent

Office (R. 443–452). Petitioner thereupon filed suit (R. 1–10) in the United States District Court for the District of Columbia, seeking, under the provisions of section 4915 of the Revised Statutes, a declaration that it was entitled to the issuance of a patent on the rejected claims. The District Court allowed two of the claims [1] (R. 89, 90–92), found that the other claims disclosed no invention, and entered judgment accordingly [2] (R. 93–94). On appeal by petitioner to the Court of Appeals for the District of Columbia, the judgment was affirmed (R. 458). The Court of Appeals was of the view that the presence or absence of invention was doubtful and held that the findings of the Patent Office and the District Court should not be overturned unless clearly erroneous (R. 456).

ARGUMENT

The petitioner does not contend that the District Court's finding of no invention is without substantial support in the evidence. Petitioner's contention is that where, as the court below assumed, invention is doubtful, the applicant is entitled to the issuance of a patent, particularly where the device claimed has attained commercial success (Pet. 5–6). The decision of the court below, rejecting this contention and limit-

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[1] The claims allowed by the District Court in Nos. 45 and 92 (R. 93) differed from those rejected in that they disclosed a partially telescoped duct which communicated with the resonance chamber through the opening between the two elements of the duct. The petitioner apparently now contends (Pet. 4) that this feature was clearly disclosed in the prior patent to Powell (R. 304) and that the novelty upon which the allowance of these claims must, therefore, have been predicated is also disclosed in most of the claims disallowed by the District Court. At the hearing before the District Court, however, the petitioner's expert, Professor Chamberlain, testified that the Powell patent differed in material particulars (R. 84–85), and the Commissioner of Patents did not appeal from the District Court's allowance of these claims.

[2] The District Court made no finding of no invention in its findings of fact (R. 90–92); the finding of no invention was included, however, in the conclusions of law (R. 92). The court's omission to include the finding of no invention in its findings of fact was not mentioned in petitioner's statement of points on appeal to the court below (R. 95–98; 457), and since this point was not brought to the attention of the District Court (R. 457) the court below found it unnecessary to consider it (R. 457).

ing its review to the question whether there was substantial evidence to support the finding of no invention, is in accord with settled principles and presents no question which warrants review by this Court.

1. The question of invention is one of fact. *United States* v. *Esnault-Pelterie,* 299 U. S. 201, 205. The scope of appellate review under the provisions of section 4915 of the Revised Statutes, insofar as it relates to a question of fact, was accurately stated by the court below to be limited to the question of whether the finding that there was no invention was clearly wrong (R. 456). A proceeding under section 4915 of the Revised Statutes is an equity action, and follows the ordinary course of equity practice and procedure. *Butterworth* v. *Hoe,* 112 U. S. 50, 61. It is well established that the findings of fact of the trial court in an equity case will not be disturbed unless clearly erroneous or without support in the evidence. *Warren* v. *Keep,* 155 U. S. 265; *Furber* v. *Ferris,* 145 U. S. 132; *Tilghman* v. *Proctor,* 125 U. S. 136, 149; *Borden's Farm Products Co., Inc.* v. *Ten Eyck,* 297 U. S. 251, 261; *Great Atlantic & Pac. Tea Co.* v. *Grosjean,* 301 U. S. 412, 420. The doctrine is applicable in principle to proceedings under section 4915 of the Revised Statutes and has been so applied by the court below in previous cases. *Minnesota Mining & Mfg. Co.* v. *Coe,* 118 F. (2d) 593, certiorari denied October 13, 1941, Nos. 257, 258, 259, this Term; *Abbott* v. *Coe,* 109 F. (2d) 449, 451; *Wolf* v. *Coe,* 112 F. (2d) 857; *Eppensteiner* v. *Coe,* 114 F. (2d) 457; *Forward Process Co.* v. *Coe,* 116 F. (2d) 946, 947; cf. *Walker,* Patents (Dellers ed.), sec. 629. It is of peculiar force where, as here, the contested finding has been concurred in by both the Commissioner of Patents and the district court. *Abbott* v. *Coe,* at p. 452; cf. *United States* v. *Commercial Credit Co., Inc.,* 286 U. S. 63, 67.

The petitioner contends that where the presence or absence of invention is doubtful, the applicant is entitled to the issuance of a patent as a matter of law. This contention is without substance. The practice of the Patent Office, it is true, has been to

resolve doubt as to invention in favor of the applicant, in the view that the issuance of the patent confers no vested right, but merely enables the applicant to establish the validity of the patent in an infringement proceeding. *In re Thomsen*, 26 App. D. C. 419, 425. The practice is not required by statute, however,[3] and on principle, rejection of an application by the Patent Office should be sustained whenever "there is found to be a rational basis for the conclusions approved by the administrative body". *Mississippi Valley Barge Line Company* v. *United States*, 292 U. S. 282, 286–287; *Rochester Tel. Corp.* v. *United States*, 307 U. S. 125, 146.[4] The court below has consistently so held in previous decisions. *Minnesota Mining & Mfg. Co.* v. *Coe*, 118 F. (2d) 593, certiorari denied October 13, 1941, Nos. 257, 258, 259, this Term; *Forward Process Co.* v. *Coe*, 116 F. (2d) 946, 947; *Eppensteiner* v. *Coe*, 114 F. (2d) 457; *Wolf* v. *Coe*, 112 F. (2d) 857; *Abbott* v. *Coe*, 109 F. (2d) 449, 451; see also *Poulsen* v. *Coe*, 119 F. (2d) 188, 200, 203. In the view most favorable to petitioner, the duty of the district court in an equity proceeding under section 4915 is to make an independent determination of the factual issue of invention, and on settled principle, the determination of the district court must be sustained unless clearly erroneous or without substantial support in the evidence. See cases cited *supra*.

The cases referred to by petitioner (Pet. 17–19), involving a direct appeal from the Patent Office either to the Court of Customs and Patent Appeals or to the Court of Appeals of the District of Columbia prior to the transfer of jurisdiction of such appeals from the latter to the former court (Act of March 2, 1929, 45 Stat. 1475, 1476) do not aid petitioner. The Court of

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[3] The patent law authorizes the issuance of a patent to any person who has "invented or discovered any new or useful art," etc. (R. S. sec. 4886) and directs the Commissioner of Patents, on the filing of an application, to issue a patent if, upon examination, the applicant is "justly entitled to a patent under the law" (R. S. sec. 4893).

[4] In view of the practice of the Patent Office to resolve doubts in favor of the applicant, the action of the Commissioner in issuing a patent should be entitled to substantially less weight.

Customs and Patent Appeals has consistently held that where, as here, the claimed invention is of a technical character, the decision of the Patent Office tribunals should be affirmed unless clearly erroneous. *Angell* v. *Morin*, 69 F. (2d) 646 (Cust. & Pat. App.); *In re Demarest*, 38 F. (2d) 895 (Cust. & Pat. App.); *In re McDonald*, 47 F. (2d) 802 (Cust. & Pat. App.). Moreover, in such cases, the court is "part of the machinery of the Patent Office for administrative purposes" and renders "a mere administrative decision." *Postum Cereal Company* v. *California Fig Nut Company*, 272 U. S. 693, 698–699. Decisions in such proceedings, as the court below observed (R. 456), have no bearing on the scope of appellate review in judicial proceedings. *Minnesota Mining & Mfg. Co.* v. *Coe*, 118 F. (2d) 593, certiorari denied October 13, 1941, Nos. 257, 258, 259, this Term; *Abbott* v. *Coe*, 109 F. (2d) 449, 451.

The decisions of the court below in section 4915 proceedings, cited by petitioner (Pet. 20), do not support the petitioner's contention. In all of them the court held that the decision of the Patent Office and the trial court was clearly erroneous. *Thornton* v. *Coe*, 102 F. (2d) 247, 252; *Carbide & Carbon Chemicals Corp.* v. *Coe*, 102 F. (2d) 236, 242; *Battery Patents Corp.* v. *Coe*, 93 F. (2d) 220, 226–27. Cf. *Freyn Engineering Co.* v. *Coe*, 79 F. (2d) 134, 135. In cases of doubt the court below has consistently held that the findings of the Patent Office and the district court must be affirmed. See *Minnesota Mining & Mfg. Co.* v. *Coe*, 118 F. (2d) 593, 594, certiorari denied October 13, 1941, Nos. 257, 258, 259, this Term; *Forward Process Co.* v. *Coe*, 116 F. (2d) 946, 947; *Eppensteiner* v. *Coe*, 114 F. (2d) 457; *Wolf* v. *Coe*, 112 F. (2d) 857; *Abbott* v. *Coe*, 109 F. (2d) 449, 451; see also *Poulsen* v. *Coe*, 119 F. (2d) 188, 200, 203.

2. The petitioner contends that, where there is a substantial doubt of lack of invention, the courts, in a proceeding under section 4915, are required to resolve the doubt in favor of the applicant where the claimed invention has achieved commer-

cial success. The contention is without substance. The decisions of this Court establish that commercial success is a factor to be considered but is by no means conclusive. *Thropp's Sons Co.* v. *Seiberling,* 264 U. S. 320, 330; *McClain* v. *Ortmayer,* 141 U. S. 419. The cases cited by petitioner, as the language quoted in petitioner's brief discloses (Pet. 14–16), merely hold that commercial success may justify, but not compel, the conclusion that the patent is valid.

CONCLUSION

The decision below is in accord with settled principle and no conflict exists. It is respectfully submitted, therefore, that the petition for writ of certiorari should be denied.

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NOVEMBER 1941.

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